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| 10/625,878 | 07/24/2003 | Mark Bradford Keener | | 9290 |

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| EXAMINER |
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NGUYEN, TAN D

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| ART UNIT | PAPER NUMBER |
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04/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| Office Action Summary | Application No. 10/625,878 | Applicant(s) KEENER, MARK BRADFORD | |
| | Examiner Tan Dean D. Nguyen | Art Unit 3689 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed 9/9/05 has been entered. Claims 1-27 (system) are pending and rejected as below.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-27 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-27 deal with a system which includes a hierarchy comprises a number of layers which are not considered as structural elements or functional elements or devices and thus are not considered as "machine" or "apparatus" and do not meet the 101 test. The system appears to be a "machine" or "apparatus" but contains no structural elements or devices or functional elements. A hierarchy comprises a number of layers (organization charts) are not structural elements.

Claim Rejections - 35 USC § 112

3. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: In claim 1, there are no indication or citation of the relationship between the layers (a)-(m). The

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dependent claims do not further indicate the relationship between the elements of (a)-(m).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over LAKIS.

As of 9/19/2005, claim 1 is as followed:

1. (Currently Amended) A system for identifying relationship between business processes and technology using a protocol to form a dependency and impact hierarchy, wherein the hierarchy comprises:
 - a. a business organization object layer;
 - b. a business unit object layer;
 - c. a business process object layer;
 - d. a mechanism object layer;
 - e. a client object layer comprising an application user interface executable on a user input device;
 - f. an input device object layer comprising a device adapted for the input, viewing, or manipulation of data and programs;
 - g. a shared infrastructure services object layer comprising a technical service;
 - h. an application object layer comprising a member of the group consisting of software, an operating system, a program, data, and combinations thereof;
 - i. a shared data storage object layer comprising a shared data storage technical infrastructure object;
 - j. a server object layer comprising a server technical infrastructure component; k.
a network object layer comprising a network technical infrastructure component;

k. a shared network infrastructure object layer comprising an individual network object; and

m. a security device object layer comprising a security device technical infrastructure component.

It appears that claim 1 deals with an apparatus for identifying relationship between business processes and technology. Note that in an apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does like forming a hierarchy chart. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Therefore, items (a)-(m) of claim 1 above are not structural elements or structures but merely chart structures (object layer) or chart hierarchy, thus items (a)-(m) have no patentable weight in an apparatus claim.

As for independent system claim 1, LAKIS discloses a system/apparatus for identifying relationship between business processes and technology using a protocol to form a dependency and impact hierarchy see Figs. 6, element 76-78, "Display Hierarchical Structure", Fig. 7, Figs. 8-10. As for the different layers as shown in (a)-(m), they are not elemental structures or devices or functional elements and thus having no patentable weight in an apparatus claim as indicated above. Moreover, the different layers are shown in Fig. 7 and 8 and 9. Alternatively, the use of the same business

management system/apparatus for identifying relationship of other similar business management processes or enterprises would have been obvious as mere applying the same system to other similar business system.

As for dep. claims 2-27 (part of 1 above), which deal with parameters with respect to hierarchical layers or hierarchical relationship and program files to carry out the object layers, they are not elemental structures or devices or functional elements and thus having no patentable weight in an apparatus claim as indicated above.

Moreover, the parameters about the object layers and relationships of the layers are shown in Fig. 7 and 8 and 9. Also, the program files or data files to carry out the apparatus claims are inherently included in the teachings of Fig. 1 of LAKIS.

Alternatively, the use of the same business management system/apparatus for identifying relationship of other similar business management processes or enterprises would have been obvious as mere applying the same system to other similar business system.

8. Claims 1-27 are rejected (2nd time) under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over CARD ET AL.

As for independent system claim 1, CARD ET AL discloses a system/apparatus for identifying relationship between business processes and technology using a protocol to form a dependency and impact hierarchy see Figs. 2-4, or 9-11. As for the different layers as shown in (a)-(m), they are not elemental structures or devices or functional elements and thus having no patentable weight in an apparatus claim as indicated above. Moreover, the different layers are shown in Figs.

2-4 or 9-1. Alternatively, the use of the same business management system/apparatus for identifying relationship of other similar business management processes or enterprises would have been obvious as mere applying the same system to other similar business system.

As for dep. claims 2-27 (part of 1 above), which deal with parameters with respect to hierarchical layers or hierarchical relationship and program files to carry out the object layers, they are not elemental structures or devices or functional elements and thus having no patentable weight in an apparatus claim as indicated above. Moreover, the parameters about the object layers and relationships of the layers are shown in Figs. 2-4 or 9-11. Also, the program files or data files to carry out the apparatus claims are inherently included in the teachings of Figs. 1, 14-15 of CARD ET AL. Alternatively, the use of the same business management system/apparatus for identifying relationship of other similar business management processes or enterprises would have been obvious as mere applying the same system to other similar business system.

9. Claims 1-27 are rejected (3rd time) under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over HILL et al.

As for independent system claim 1, HILL ET AL discloses a system/apparatus for identifying relationship between business processes and technology using a protocol to form a dependency and impact hierarchy see Fig. 4, cols. 9-10. As for the different layers as shown in (a)-(m), they are not elemental structures or devices or functional elements and thus having no patentable weight in an apparatus claim as indicated

above. Moreover, the different layers are shown in Figs. 3A and 4. Alternatively, the use of the same business management system/apparatus for identifying relationship of other similar business management processes or enterprises would have been obvious as mere applying the same system to other similar business system.

As for dep. claims 2-27 (part of 1 above), which deal with parameters with respect to hierarchical layers or hierarchical relationship and program files to carry out the object layers, they are not elemental structures or devices or functional elements and thus having no patentable weight in an apparatus claim as indicated above. Moreover, the parameters about the object layers and relationships of the layers are shown in Figs. 3A and 4. Also, the program files or data files to carry out the apparatus claims are inherently included in the teachings of Fig. 1 of HILL ET AL. Alternatively, the use of the same business management system/apparatus for identifying relationship of other similar business management processes or enterprises would have been obvious as mere applying the same system to other similar business system.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) JP 408329156A, provides an organization chart processor for displaying an organization chart by a tree structure so that position of a specified employee (entity) in the whole belonging organization can be shown. It's cited here for applicant's awareness of potential use in the future if needed to avoid duplicate rejections.

No claims are allowed.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689